

## REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed November 6, 2009. At the time of the Final Office Action, Claims 1-20 were pending in this Application. Claims 1-19 were rejected. Claim 20 was previously cancelled due to an election/restriction requirement. Claims 1 and 4 have been amended to further define various features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

### **Rejections under 35 U.S.C. §102**

Claims 1-19 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,346,107 issued to Cucin ("Cucin"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the art cited as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

With regard to claim 1, Cucin does not set forth a suction opening laterally oriented on the wall of the electrode body where the suction opening extends proximally from a working end of the active electrode terminal and is in communication with the electrode lumen, as is now recited by amended claim 1. The suction opening described by Cucin does not extend to a working end of the electrode body, but is rather contained entirely between the ends of the electrode body. Because Cucin does not set forth all of the elements of claim as amended, Cucin cannot anticipate amended claim 1. For at least these reasons, Applicants submit that amended claim 1 is in condition for allowance, and respectfully request withdrawal of the rejection.

Claims 2-19 depend either directly or indirectly from claim 1. Applicants hereby repeat and incorporate the comments made above with regard to amended claim 1. For at least these

reasons, Applicants submit that claims 2-19 are in condition for allowance and respectfully request withdrawal of the rejection.

**Request for Continued Examination (RCE)**

Applicant encloses a Request for Continued Examination (RCE) Transmittal, and hereby authorized the Commissioner to charge \$810 to Deposit Account No. 50-0359 of ArthroCare Corporation.

### CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

The Commissioner is hereby authorized to charge \$810 for the RCE to Deposit Account No. 50-0359 of ArthroCare Corporation. Applicant believes there are no additional fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.358.5925.

Respectfully submitted  
Attorney for Applicants,



Matthew Scheele  
Reg. No. 59,847

Date: 2/5/10

CORRESPONDENCE ADDRESS:

ARTHROCARE CORPORATION

CUSTOMER NO. **21394**

512.358.5925

512.391.3901 (fax)